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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,193	08/29/2001	Kenneth M. Riff	P-9618.00	8485

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MEDTRONIC, INC.
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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/943,193

Applicant(s)

RIFF ET AL.

Examiner

Vanel Frenel

Art Unit

3626



--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 07 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.Claim(s) objected to: None.Claim(s) rejected: 1-21,32-47 and 66-74.Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER

Continuation of :5

Note: First, Applicant's argues grounds of rejection unclear under 35 USC 103(a) over Albert in view of Brown and the rejection does not provide a prima facie case of obviousness and the Examiner is requested to clarify which references are relied for each element of the claims for any subsequent rejection. Second, Applicant's argues the Examiner has failed to provide any valid motivation for making such a combination, then further drastically modifying the combination to change it into the presently claimed invention. Third, Applicant's argues Kricken et al is not a proper reference.

(A) In response to Applicant first argument, Examiner respectfully submits that it was an inadvertent typographical error in not mentioning the Brown reference. In light of Applicant's response it appears Applicant recognizes that Brown was indeed relied upon as noted in the bodies of the rejections, as indicated by references to Brown in Paper No.7.

(B) In response to Applicant's second argument, Examiner respectfully suggests that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed.1326, 160 USPQ 806, *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F. 2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir.1988) citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 Fed. Cir.1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that :

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

(C) Applicant argues that a fee for consultation is not a fee for information.

In response to Applicant argument, Examiner respectfully suggests that Sato discloses "The accounting terminal 303 calculates the treatment fee for the treatment content executed by the doctor for the patient and transfers the result to the accounting file 306 in the file server. The data sent to the accounting file 306 is saved by the end of month and used for demand for medical expense payment for the Ministry of Welfare" which correspond to Applicant's claimed feature (See Sato, Col.7, lines 10-15). Therefore, Applicant's argument is not persuasive.

(D) In response to Applicant's third argument Kricken is not a proper reference, the Examiner respectfully disagrees since the filing date of the invention is made on 08/29/01 and the assignment to Medtronic on 10/04/01. As such, the assignee did not commonly own the applied reference and the present invention at the time of the invention. See attached Patent Assignment Abstract of Title Data Sheet. Therefore, Applicant's argument is not persuasive.

(D) Applicant's remaining arguments rely upon those arguments addressed above, and are likewise moot for the reasons set forth in the preceding responses.